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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/722,410	11/28/2000	Satoru Okada	723-951	4624

7590 01/28/2003

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EXAMINER
WHITE, CARMEN D

ART UNIT	PAPER NUMBER
3714	

DATE MAILED: 01/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/722,410	OKADA ET AL.	
	Examiner	Art Unit	
	Carmen D. White	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-113 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) 1-113 are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-35 drawn to a hand-held display system for playing video games, classified in class 463, subclass 31.

II. Claim 36 drawn to a cable for connecting a master hand-held display system with a slave hand-held display system for playing video games, classified in class 463, subclass 47.

III. Claims 37-51 drawn to a method of generating a display in a system for playing video games by displaying graphical information based on part on a user interaction provided through operation of a user-manipulable control, classified in class 463, subclass 30.

IV. Claims 52-55 drawn to a method of monitoring the status video game play that includes decoding bit positions, classified in class 463, subclass 1.

V. Claims 56-57 drawn to a method of controlling display status in a video game playing system that includes writing control bits to bit positions classified in class 463, subclass 1.

VI. Claims 58-59 drawn to a method of generating a video game display based on a display instruction that includes decoding a three-bit background mode specifier, classified in class 463, subclass 31.

VII. Claims 60, drawn to a method of generating a video game display based on a display instruction that includes decoding a two-bit priority specification, classified in class 463, subclass 31.

VIII. Claim 61, drawn system for allowing a person to play a video game by interactively displaying graphical information on a display, classified in class 463, subclass 31.

IX. Claim 62 drawn to a method for controlling rotation and/or scaling in a system capable of video game play, classified in class 463, subclass 31.

X. Claim 63, drawn to a method for decoding a windowing command in a system capable of playing a video game, classified in class 463, subclass 31.

XI. Claims 64-86, drawn to a replaceable memory cartridge for use with a handheld video game platform, classified in class 463, subclass 44.

XII. Claims 87-101, drawn to a pluggable memory cartridge for use in a system for playing video games, classified in class 463, subclass 44.

XIII. Claims 102-103, drawn to a memory cartridge for a vide game system that has a memory device that stores an instruction for writing a 16-bit value at a memory location that has a bit position 00 specifying vertical blanking interval status classified in class 463, subclass 44.

XIV. Claims 104-105 drawn to a memory cartridge for a video game system that has a memory device that stores an instruction for writing a 16-bit value at a memory location that has a bit position 03 specifying whether

vertical blanking interval interrupts are enabled, classified in class 463, subclass 44.

XV. Claims 106-109, drawn to a memory cartridge for a video game system that has a memory device that stores an instruction that writes a 16-bit word at a memory location that has a three-bit background mode specifier to bit positions 00-02, classified in class 463, subclass 44.

XVI. Claim 110, drawn to a memory cartridge for a video game system that has a memory device that stores an instruction that writes a 16-bit value to a location 008h or 00Ah, classified in class 463, subclass 44.

XVII. Claim 111, drawn to a memory cartridge for a video game system that has a memory device for storing an instruction that selects a mosaic object display mode, classified in class 463, subclass 44.

XVIII. Claim 112, drawn to a memory cartridge for a video game system that has a memory device for storing an instruction that controls rotation and/or scaling, said instruction causing data to be writing to a rotation/scaling control register, classified in class 463, subclass 44.

XIX. Claim 113, drawn to a memory cartridge for a video game system having a memory device that stores an instruction that writes a 16-bit value to location 048h classified in class 463, subclass 44.

The inventions are distinct, each from the other because of the following reasons:

Inventions (I) and (III, VI, VII) are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1)

that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the video game display of (I) can be made various types of different processes as can be seen in the four distinct methods of inventions (III, VI, and VII)

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination of (I), which discloses a hand-held display system that has a connector could be used with an entirely different cable as a connector, than described in the subcombination of (II). The subcombination has separate utility such as such as a connector for various other types of video games that are connected in a network to game devices in remote areas.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

This application contains claims directed to the following patentably distinct species of the claimed invention: Groups III, VI and VII are directed to different embodiments for generating a display for a video game.

This application contains claims directed to the following patentably distinct species of the claimed invention: Groups III, VI and VII are directed to different embodiments for generating a display.

Claims in (I, II) are distinct embodiments from (III, VI and VII), which are different embodiments than (IV), (V), (VIII), (IX), (X) and (XI, XII, XIII, XIV, XV, XVI, XVII, XVIII, XIX).

Similarly, claims in XI, XII, XIII, XIV, XV, XVI, XVII, XVIII and XIX disclose different embodiments of inventions that are drawn to memory cartridges for a video game system.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

USPTO Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carmen D. White whose telephone number is 703-308-5275. The examiner can normally be reached on Monday through Friday, 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone numbers

for the organization where this application or proceeding is assigned are 703-308-7768 for regular communications and 703-305-3579 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1078.

C. White
Patent Examiner